

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of July 16, 2008 and respectfully requests reconsideration of the application.

### I. Claim 13

Claim 13 is discussed in paragraph 6 of the Action. Claim 13 recites as follows:

13. A data processing system, comprising:

a plurality of communications links designed to communicate trade information to and from a plurality of workstations, the trade information comprising information describing orders in an electronic market for items offered for sale or bid to buy, at least some of the trade information to be presented to the workstations;

a commission processor programmed to receive information relating to execution of trades in the items, and to determine a commission payable by a customer to a trade, or to apply a credit against commission fees to the customer, based at least in part on one or more characteristics from the group consisting of the time of the trade, day of the trade, location of a trade, and the customer trading location.

#### A. The Office Action Misstates the Content of the Prior Art – Applicant Traverses Any Assertions Lacking Substantial Evidence Support

The Office Action asserts as follows, with no citation to any evidence:

However, commissions and fees are known where customers are charged for services by service provider. Similarly, it is known that there are two ways broker make money (income), for his/her service, from charging a commission or spreads between buying price and selling price, where commission charges may be based on different criteria.

Applicant requests identification of a document showing that “it is known that ... broker make money ... from ... spreads between buying price and selling price.” The Office Action is incorrect: it misstates the roles of parties in a securities market. Principals “make money on a spread.” A broker, by definition, does not hold a position or make money on price differences. A broker is not a principal to a trade. Regulations may bar the conflicts of interest that would arise if a broker did make money on the spread, instead of acting as a neutral intermediary.

Pursuant to 37 C.F.R. § 1.104(d)(2), Applicant calls for substantial evidence to support this step in the reasoning, or withdrawal of the rejection.

MPEP § 2144.03(B) requires that if any fact is asserted to be “well-known prior art,” “the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” No such basis was set forth in the Office Action for the assertion that brokers make money on spreads. The Office Action is too incomplete to state any rejection.<sup>1</sup>

Similarly, the Office Action asserts that one of ordinary skill would be motivated to combine Anthonyson ’624 with Gianakouros ’901 “to allow individuals to benefit from different type of service by the service provider to optimize it [sic] cost with respect to service customer gets.” The Office Action does not state a “basis,” in violation of MPEP § 2144.03(B). The Office Action cites no evidence to believe that this motivation existed before the invention was made. Pursuant to 37 C.F.R. § 1.104(d)(2), Applicant calls for substantial evidence to support this step in the reasoning.

**B. Anthonyson ’901 is Not Analogous Art and Therefore Not Available as an Obviousness Reference**

Anthonyson ’901 would not be considered analogous art by one of skill in the securities trading art. *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) states the 2-part test for analogous and non-analogous art:

The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Securities trading is not the same “field of endeavor” as parking cars. Securities trading is heavily regulated, parking is not. Parking is by definition intensely local, securities trading is national. A securities trading business is not likely to also be in the business of running parking garages. At any rate, there is no evidence to suggest overlap in the two markets.

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<sup>1</sup> Agency actions are void – that is, they have no legal existence – when an agency fails to make the showings required in the agency’s own procedural handbook. *Service v. Dulles*, 354 U.S. 363, 388-89 (1957) (vacating agency action issued in violation of guidelines stated in an unpublished agency manual). An action taken in violation of “applicable departmental regulations” is “illegal and of no effect.” *Vitarelli v. Seaton*, 359 U.S. 535, 545 (1959); *Dodson v. Dept. of the Army*, 988 F.2d 1199, 1204 (Fed. Cir. 1993) (once an agency promulgates regulations, it is bound to follow them).

Nor is Anthonyson's problem "reasonably pertinent" to securities trading. Anthonyson states his "problem" as follows (col. 2, lines 49-56, and col. 3, lines 5-26):

The present invention overcomes the disadvantages of the prior art by providing an automatic parking system that can identify a vehicle approaching an entrance or exit lane, and then, based on that identity, generate an appropriate set of responses such as opening a gate, illuminating a fee display, posting accounting information, preparing periodic statements to the owner of the vehicle, and the like.

Thus, it is an object of the present invention to provide an automated vehicle parking system.

It is also an object of the present invention to provide an automated vehicle parking system that senses a vehicle, transmits an interrogation signal to the vehicle and, if the vehicle has a compatible tag or transponder, receives from the vehicle an identification number for use in system computers for calculating costs for that particular vehicle.

It is also an object of the present invention to provide an automated parking facility in which the gates are opened and closed according to a transponder signal received from the vehicle when interrogated.

It is still another object of the present invention to provide an automated vehicle parking system in which various parking products such as by the hour, by the day, monthly parkers, daytime only, weekend only, and the like can be applied to a particular vehicle, and the costs automatically calculated on a real time basis and stored in an accounting system from which periodic billings can be issued to the customer owning the vehicle or can be used in debit accounting.

None of Anthonyson's statements of the problem relate to any "particular problem" of securities trading or "particular problem" solved by the invention.

Anthonyson is not available as an obviousness reference.

### **C. Claims 23, 25 and 37**

The Office Action's discussion of claims 23, 25 and 37 relies on the same reasoning discussed above.

### **D. Dependent claims**

The dependent claims are patentable with the independent claims discussed above, and recite further limitations that further distinguish the art.

## **II. Paragraph 4 of the Action Is Confusing**

Paragraph 4 of the July 2008 Office paper is unclear, because it does not arise under any statutory requirement. Rather, it appears to be a mix-and-match among several non-combinable legal requirements.

Claims 13, 55-63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 13 (line 2) recites in the limitations "a plurality of communication links", the body of the claim does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function.

Claim 13 (line 6) recites "a commission processing module", consist of module (software according to the specification) that does not describe the structure of the device that performs the function. A system or an apparatus claim should always claim the structure of device that performs the function. Appropriate correction is required.

There is no such thing as a requirement for "limitations indicating the structure" under § 112 ¶ 2. MPEP § 2174 cautions that the requirements on the specification arising under 35 U.S.C. § 112 ¶ 1 must not be confused with the requirements on claims arising under 35 U.S.C. § 112 ¶ 2. Applicant has searched MPEP §§ 2171-2174, and there is nothing there relevant to "structure of the device." Applicant cannot connect the discussion in the Office Action to any known principle of patent law.

Applicant's prior papers have noted that Examiner Dass' papers are confusing at best in their statements of law. Applicant again requests that the Examiner identify a document having force of law to support any § 112 ¶ 2 rejection. Prosecution cannot proceed efficiently if examination is unmoored from established principles of law.

Paragraph 4 is insufficient to raise any rejection at all. If any issue is properly explained in the future, it will be a "new ground of rejection" that prevents final rejection.

### III. Paragraph 3 of the Office Action is Insufficient to Raise Any Rejection

Paragraph 3 of the Office Action reads as follows:

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The system claims 13 is non-statutory because it is directed non-descriptive material and does not claim any structure (software per se), lacking storage on a medium (basically no hardware), which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.

Applicant's paper of September 2007 noted that a previous § 101 issue was also poorly framed, and Applicant provided the following flowchart from MPEP § 2106:

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**DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH THE SUBJECT  
MATTER ELIGIBILITY REQUIREMENT OF 35 U.S.C. 101**

- Does the Claimed Invention Fall Within an Enumerated Statutory Category?
- Does the Claimed Invention Fall With a 35 U.S.C. 101 Judicial Exception – Law of Nature, Natural Phenomena or Abstract Idea?
- Does the Claimed Invention Cover a 35 U.S.C. 101 Judicial Exception, or a Practical Application of a 35 U.S.C. 101 Judicial Exception?
  - Practical Application by Physical Transformation?
  - Practical Application That Produces a Useful (35 U.S.C. 35 U.S.C. 101 utility), Tangible, and Concrete Result?
- Does the Claimed Invention Preempt a 35 U.S.C. 101 Judicial Exception (Abstract Idea, Law of Nature, or Natural Phenomenon)?
- Establish on the Record a Prima Facie Case

What is “non-descriptive material?” It is not a legal term of art, no claim language is identified, no case or MPEP section is identified to explain what is meant. The Action says the claim has “basically no hardware” – why is a “workstation” not “hardware?” The Action refers to “instructions” – there are no “instructions” in claim 13 – to what is the Action referring? Why is there no discussion of claim language? Why is there no identification of a “law of nature, natural phenomenon or abstract idea?” Why is there no discussion of practical application, physical transformation, “useful, concrete and tangible result,” or preemption?

The lack of conformity between the Action and MPEP § 2106 or any other recognizable law renders any reply impossible. If any § 101 issue is thought to apply, it should be explained in the manner instructed by the Director in the MPEP.

Paragraph 3 is insufficient to raise any rejection at all. If any issue is properly explained in the future, it will be a “new ground of rejection” that prevents final rejection.

#### **IV. Conclusion**

A Petition for Extension of Time extends the shortened statutory period through January 16, 2008. Accordingly, this reply is timely.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1016.

Respectfully submitted,

Dated: January 16, 2009

By: /David E. Boundy/  
Registration No. 36,461

110 East 59th St.  
New York, NY 10022  
(212) 294-7848  
(917) 677-8511 (FAX)